CASE PP/1-21435/A/CONT/RE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

N RE REISSUE OF:
'ATENT NO. 6,365,653 B1
SSUE DATE: APRIL 2, 2004
ATENTEES: HANS-RUDOLF MEIER ET AL
APPLICATION NO: UNASSIGNED
FILED: HEREWITH
FOR: THIODIPROPIONIC ACID BISAMIDES AS STABILIZERS FOR NONBLACK ELASTOMERS

Group Art Unit: 1714
Examiner:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ASSENT BY ASSIGNEE FOR FILING OF REISSUE APPLICATION

Sir:

Ciba Specialty Chemicals Corporation is the assignee of an undivided interest to the above original patent as evidenced by the assignment records at the United States Patent and Trademark Office (Reel/Frame) (011773/0750), recorded on April 30, 2001. Ciba Specialty Chemicals Corporation hereby assents to the accompanying application for reissue.

Respectfully submitted,

By: _____
JoAnn Villamizar,
Reg. No. 30,598
Vice President and Patent Counsel
Date: 2/2/04

KTM\21435RE_Assent

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DECLARATION UNDER 37 C.F.R. § 1.175 AND POWER OF ATTORNEY FOR U.S. REISSUE APPLICATION

Sir:

As below named inventors, we hereby declare that:

Our residence, post office addresses and citizenship are as stated below next to our names.

We believe we are the original, first and joint inventors of the subject matter which is claimed and for which a reissue is sought on the invention entitled

"THIODIPROPIONIC ACID BISAMIDES AS STABILIZERS FOR NONBLACK ELASTOMERS"

which is described and claimed in U.S. Patent No. 6,365,653 B1, which issued on April 2, 2004 from application No. 09/698,971, filed October 27, 2000, which is a continuation of application No. 09/188,591, filed November 9, 1998, abandoned.

We hereby state that we have reviewed and understand the contents of the above-identified patent, including the claims.

We believe the patent to be wholly or partly inoperative by reason of the patentees claiming both less and more than they had a right to claim in the patent. Specifically, 2 preferred definitions of R_1 are disclosed on page 2, line 16 of the disclosure. The narrower definition was erroneously incorporated into independent claims 10, 13 and 14 of the application, now claims 1, 3 and 12 of the patent, i.e. R_1 was defined as **C_3-C_8alkyl** instead of **C_3-C_{12}alkyl** in the Amendment mailed on September 9, 2001. We believe this was a simple copying error – there was absolutely no reason related to patentability to restrict the upper limit of the alkyl chain to C_8. Hence patentees are claiming less than they have a right to claim in claims 1, 3 and 12 of the patent.

Patentees' agent soon noted the above errors with regard to independent claims 10, 13 and 14 of the application, and a Substitute Amendment correcting them was sent via telefax to the PTO on September 19, 2001. The examiner was informed by telephone that the Amendment mailed on September 9, 2001 contained errors and that a Substitute Amendment correcting them had been sent to the PTO via telefax. Therefore it was not noticed for some time that the claims of the patent corresponded to those of the Amendment mailed on September 9, 2001, not the corrected Substitute Amendment sent to the PTO via telefax shortly thereafter.

Additionally, in independent claims 10, 13 and 14 of the application, now claims 1, 3 and 12 of the patent, R_1 was defined as C_3-C_8alkyl, i.e. "hydrogen or" was cancelled. Also n was defined as 1 or 2, i.e. the meaning n = 0 was cancelled. This amendment was made to distinguish over the thioether bis amides (R_1 = hydrogen; n = 0) disclosed in Klein (U.S. Patent No. 3,975,414). Yet dependent claim 2 of the patent recites, "R_1 is hydrogen or C_3-C_8alkyl" and "n is the number 0 or 1". Clearly "hydrogen or" and "0 or" should have been cancelled, because claim 2 is broader than the claim it depends upon. Hence patentees are claiming more than they have a right to claim in claim 2 of the patent.

Patentees therefore seek to correct claims 1-3 and 12 of the patent to correct the above-mentioned errors.

Patentees believe that the errors arose without any deceptive intent on the part of the applicants. We believe that the errors arose due to a simple copying error and an oversight on the part of Patentees' agent. Moreover, an earnest effort to correct the errors to claims 10, 13 and 14 of the application was

made as soon as they were noted. The errors in claim 2 of the patent were not noticed until much later.

The accompanying Amendment broadens the scope of claims 1, 3 and 12 of the patent since the upper carbon limit of the alkyl chain has been increased to its original value. The request for reissue is being filed within two years of the issue date (April 2, 2004).

We acknowledge the duty to disclose all information, which is known by us to be material to the patentability of this application as defined in 37 C.F.R. § 1.56.

We hereby claim the benefit under 35 USC § 119(a) of priority of application No(s). 2641/97 filed on November 14, 1997 in Switzerland.

We hereby appoint the following attorneys and agents, associated with Customer No. 000324, each of them with full power of substitution, revocation and appointment of associates, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

JoAnn L. Villamizar (Reg. No. 30,598), Kevin T. Mansfield (Reg. No. 31,635) and Tyler A. Stevenson (Reg. No. 46,388).

Address all correspondence associated with Customer No. 000324 to ***Ciba-Specialty Chemicals Corporation, Patent Department, 540 White Plains Road, P.O. Box 2005, Tarrytown, NY 10591-9005***.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first joint inventor: **Hans-Rudolf MEIER**

Inventor's signature: _____ Date 4/February 2004
day/month/year

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Citizenship: **Swiss**

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Full name of second joint inventor: **Gerrit KNOBLOCH**

Inventor's signature: _____ Date 4/February/2004
day/month/year

Residence: **Im Stigler 25**
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Post Office Address: same as above